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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,385	04/02/2004	Stephen P. Fracek JR.	98006/16C1	2876
23873 7590 01/30/2009 ROBERT W STROZIER, P.L.L.C. PO BOX 429 BELLAIRE, TX 77402-0429				
EXAMINER				
PAULS, JOHN A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/817,385

Applicant(s)

FRACEK ET AL.

Examiner

JOHN A. PAULS

Art Unit

4114

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-893)
Paper No(s)/Mail Date 2 April 2004
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the application filed on 2 April, 2004
2. Claims 1 - 14 are currently pending and have been examined.

Information Disclosure Statement

3. The Information Disclosure Statement filed on 2 April, 2004 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Priority Claims to Earlier Filed Application

4. Applicant has claimed priority to provisional application 60/169175 filed 6 December, 1999. However, the present application must be an application for a patent for an invention which is also disclosed in the prior application (the provisional application). The disclosure of the invention in the provisional application and in the present application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).
5. The disclosure of the provisional application, Application No. 60/169175 fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In Claim 1, the survey subsystem, student subsystem, clinician subsystem, staff subsystem and faculty subsystem are not supported. Claims 2, 3, 4, 5, 6 and 14 are also not supported. As a result the priority date of 6 December, 1999 is not granted for these claims and claim limitations.

Drawings

6. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because screen images depicted by Figures 13A-C; 14A,B,D,E; 15C; 16A-G; and 17A-H are not clear enough to read. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

7. The disclosure is objected to because of the following informalities: The disclosure contains the following terms: "supervisor" "student"; "clinician"; "medical staff"; "staff"; "faculty"; "supervisor"; "program directors"; "graduates"; "employer" and "instructor", however, the claims only refer to "student"; "clinician"; "staff" and "faculty". Examiner cannot determine the metes and bounds of the invention. For purposes of this examination, Examiner assumes that "clinician"; "instructor"; and "supervisor" have the same meaning (see specification page 8 line 16 – 17) and that "medical staff" and "staff" have the same meaning. Appropriate correction is required.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:
- Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
9. Claims 1—8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a system, but no structure is claimed as is required by statutory systems, because the subsystems are broadly interpreted as software, not hardware. Therefore the claims could constitute computer programs representing computer listings per se. Such descriptions or expressions of the programs are not physical "things". They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.]
10. Claims 9 - 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The steps recited do not qualify as a statutory process. In order for a method to be considered a "process" under §101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook,

437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter. Although the steps are performed using a computer, the computer is a field of use limitation because the steps are human actions that do not require (i.e. are not tied to) the computer.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims a "*staff and clinician daily log functions and clinical competencies functions comprise a validate student records function*". There is no antecedent basis in the claims for a "*staff daily log function and clinical competencies function*".
13. Claims 1 - 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A proper "system" contains physical structure. However, the "system" claimed in claims 1-8 recite no physical structure, only software. Therefore, the structure of claims 1-8 is unclear.
14. **Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated over Recigno (US 5616899 A).

CLAIM 9

Recigno as shown discloses the following limitations:

- *logging onto a system*; (see at least Recigno column 20 line 29 - 41);
- *selecting a time in function which generates a unique time in stamp*; (see at least Recigno column 20 line 60 – 62);
- *selecting a time out function after completion of a medical protocol or procedure which generates a unique time out stamp*; (see at least Recigno column 10 line 9 – 19);
- *selecting a clinician and an area identifying the instructor and the protocol or procedure*; (see at least Recigno column 10 line 9 - 19);
- *entering data associated with the protocol or procedure in appropriate fields in a GUI screen associated with the protocol or procedure*, (see at least Recigno column 5 line 57 – 67; column 7 line 38 – 45 and column 10 line 9 - 19);
- *updating the time entry record*; (see at least Recigno column 20 line 37 - 43).

CLAIM 11

Recigno as shown discloses the limitations shown above. Recigno also discloses the following limitations:

- *the system resides on a dedicated a server connected to the network*; (see at least Recigno column 5 line 1 - 29).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
19. Claims 1 - 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Recigno (US 5616899 A) and in further view of Kersting "Microcomputer Management Information System for a University Allied Health Clinical Training Program" December, 1983; and in further view of Hamlin et al. (US 6477504 B1).

CLAIMS 1 and 3 - 8

Recigno as shown discloses the following limitations:

- a GUI subsystem for interacting with a user including input screen having data input fields, selection fields and activation buttons and output screens including data output fields; (see at least Recigno column 5 line 57 - 67);
- a database subsystem for storing, manipulating and polling data including database fields corresponding to the input data field and output data field of the GUI screens; (see at least Recigno column 6 line 24 - 33);
- a logon subsystem including user identification routines to establish user identity and user system access status; (see at least Recigno column 20 line 29 - 41);

- *time in and time out routines for time stamping a user's activities associated with a given medical protocol, procedure or rotation*; (see at least Recigno column 2 line 2 - 22);
- *a time in clock function* (i.e.: start time); (see at least Recigno column 10 line 9 - 19);
- *a timeout clock function* (i.e.: finish time); (see at least Recigno column 10 line 9 - 19);
- *a view time clock records function*; (see at least Recigno column 10 line 36 - 40);
- *a generate time clock summary function*; (see at least Recigno column 10 line 36 - 40);
- *a unique time stamp for time in and time out*; (see at least Recigno column 20 line 60 - 62);
- *an elapsed time tied to a particular clinician and hospital area*; (see at least Recigno column 2 line 2 - 6);
- *the system resides on a dedicated a server connected to the network*; (see at least Recigno column 5 line 1 - 29);
- *a view records function* (i.e. retrieve); (see at least Recigno column 6 line 25 - 33);
- *a search records function* (i.e. retrieve); (see at least Recigno column 6 line 25 - 36); Examiner notes that SQL stands for Structured Query Language
- *an add record function* (i.e. add); (see at least Recigno column 6 line 25 - 33);
- *summary function*; (i.e. analytical functions); (see at least Recigno column 7 line 66 through column 8 line 3);
- *modify record function* (i.e. edit); (see at least Recigno column 6 line 25 - 33);
- *a delete record function* (i.e. edit); (see at least Recigno column 6 line 25 - 33). Examiner notes that SQL stands for Structured Query Language which includes a delete function. Recigno as shown discloses the limitations shown above. Recigno does not disclose the following limitations, however Kersting does:
- *a student subsystem including a time clock function, a daily log function, a clinical competencies function and a personal data function*; (see at least Kersting page 3, 4, 6, 8 and 30). Examiner notes that the *time clock function* has the same meaning as "clinical clock hours"; that *daily log function* has the same meaning as "document the academic and clinical experiences of students";

and that a *clinical competencies function* has the same meaning as "compliance with professional training standards". Examiner also notes that a *personal data function* is contained in the Kersting disclosure since tracking a students clinical experience would require that student personal information be included in the database.

- a *clinician subsystem including a personal daily log function, a clinical competencies function and a personal data function*; (see at least Kersting page 4 and 28). Examiner notes that Kersting discloses a system that provides for the generation of data for various management parameters including supervision hours and that data for clinicians is shared with other sites. Therefore, the Kersting disclosure has a *clinician personal daily log function, clinical competencies function and personal data functions* as parts of the system.
- a *staff subsystem including a personal data function*; (see at least Kersting page 29);
- a *faculty subsystem including a personnel data function, time clock function, a daily log function, a clinical competencies function, a summaries function*; (see at least Kersting page 4 and 29). Examiner notes that Kersting discloses a system that provides for the generation of data for various management parameters including academic supervision credit and faculty supervisory loads. Therefore, the Kersting disclosure has a *personnel data function, time clock function, a daily log function, and a clinical competencies function* as parts of the system.
- a *validate student records function*; (see at least Kersting page 34).

Examiner notes that Kersting also discloses a "database" (page 29); the "storage of clinical clock hours" (page 8); that the "system interfaces with other sites" (page 4); that the "system utilizes various computer networks" (page 20). Kersting also cites the "benefits to be derived from decentralized, distributed processing" (page 21).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the case management system of Recigno with the clinical training program of Kersting because tracking and review of a students clinical activities is necessary in order to grant certification and licensure to the student.

The combination of Recigno/Kersting discloses the limitations shown above. Recigno/Kersting does not disclose the following limitation, however Hamlin does:

- *a survey subsystem including a plurality of surveys*; (see at least Hamlin column 2 line 51 – 64);
- *the network is the internet and the system is web-based*; (see at least Hamlin column 5 line 32 – 36).

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the case management system of Recigno/Kersting with the web-based survey system of Hamlin because the use of surveys to poll members of an organization at a variety of levels and functions allows a decision maker to understand the behavior, opinions and attitudes of the surveyed population and make better decisions.

CLAIM 2

The combination of Recigno/Kersting/Hamlin discloses the limitations shown above. The combination of Recigno/Kersting/Hamlin does not specifically disclose the following limitation per se:

- *an employer survey, a graduate survey, a student survey and a program personnel survey per se.*

However, Hamlin does disclose that "a client may define their own target group" for the survey. (see at least Hamlin column 9 line 49 – 53). Therefore, It would also be obvious to one of ordinary skill in the art to at the time of the invention to combine the case management system of Recigno/Kersting with the survey system of Hamlin because the use of surveys to poll members of an organization at a variety of levels and functions allows a decision maker to understand the behavior, opinions and attitudes of the surveyed population and make better decisions.

20. Claim 10 is rejected under 35 U.S.C. 103(a) as being obvious over Recigno (US 5616899 A) and in further view of Official Notice.

CLAIM 10

Recigno as shown discloses the limitations shown above. Recigno also discloses the following limitations: *submitting the protocol data to the database and polling the entered data*; (see at least Recigno column 6 line 24 – 33 and column 7 line 66 to column 8 line 5). Recigno as shown does not specifically disclose that the data is *reviewed by a supervisor* per se. However, Recigno does disclose supervisory and

management function (see Recigno column 12 line 32 – 35; column 15 line 41 – 43 and column 7 line 66 thru column 8 line 5). Additionally, Examiner takes Official Notice that the normal function of a supervisor or manager is to review the work of subordinates. Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to modify the case management system of Recigno with the Official Notice to provide that supervisors review the work of subordinates because reviewing a subordinates work will reduce errors and increase efficiency of the department.

21. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Recigno (US 5616899 A) and in further view of Hamlin et al. (US 6477504 B1).

CLAIM 12

Recigno as shown discloses the limitations shown in the U.S.C. 102 rejection above. Recigno does not disclose the following limitations, however Hamlin does:

- *the network is the internet and the system is web- based; (see at least Hamlin column 5 line 32 - 36).*

It would be obvious to one of ordinary skill in the art at the time of the invention to combine the case management system of Recigno with the Internet connection of Hamlin because the use of the internet to connect computers allows for a distributed computer system to communicate.

22. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kersting "Microcomputer Management Information System for a University Allied Health Clinical Training Program" December, 1983; and in further view of the Liaison Committee on Medical Education (LCME) "Overview" 22 July 1997.

CLAIM 13

Kersting as shown discloses the following limitations:

- *retrieving medical student data for each medical student; (see at least Kersting page 4).*

Kersting does not specifically disclose "*determining an accreditation score*", however Kersting does disclose that student records must be used to "document compliance with professional training

standards." (see at least Kersting page 4 and 30). Examiner notes that the documented compliance with professional training standards for students in a clinical training program is a requirement for the accreditation of the program. (see the LCME Overview) Therefore it would be obvious to one of ordinary skill in the arts to modify the clinical training program of Kersting to provide that the program would submit reports to the LCME for purposes of accreditation because LCME accreditation is a requirement for the licensure of graduates.

23. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kersting "Microcomputer Management Information System for a University Allied Health Clinical Training Program" December, 1983; and in further view of the Liaison Committee on Medical Education (LCME) "Overview" 22 July 1997 and in further view of "A Journey Through the History of The Joint Commission (JCOAH), 1987.

CLAIM 14

Kersting as shown discloses the following limitations:

- *retrieving medical staff data for each medical staff*; (see at least Kersting page 6 and 30).

Kersting does not specifically disclose "*determining an institution or department accreditation score*", however Kersting does disclose that reports generated from the data document service delivery and clinician experience. (see at least Kersting page 5 and 30). Examiner notes that the documentation of organizational performance is a requirement for the accreditation of the institution. (see the JCOAH History, 1987) Therefore it would be obvious to one of ordinary skill in the arts to modify the clinical training program of Kersting to provide that the program would submit reports to the JCOAH for purposes of institutional accreditation because JCOAH accreditation is mandated by the Social Security Act of 1972.

CONCLUSION

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **John A. Pauls** whose telephone number is **571-270-5557**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **JAMES A. REAGAN** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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Date: 14 January, 2009

/JOHN A. PAULS/

Examiner, Art Unit 4114

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Supervisory Patent Examiner, Art Unit 4114